

Applicant(s) : Hartmut Sauer
Serial No. : 10/553,147
Filed : November 13, 2006
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Attorney Docket No.: 68001-005US1

AMENDMENTS TO THE DRAWINGS

The attached two new sheets of drawings includes original Figures 1-4 presented in WO 2004/091906 A2.

REMARKS

This document is submitted in reply to the Office Action dated August 7, 2008 (“Office Action”).

Applicant has amended claims 1-21 to more particularly point out the subject matter that they deem as their invention. In particular, support for amended claim 1 can be found in both original claims 1 and 3. Further, Applicant has added three new claims, i.e., claims 22-24. Support for which can be found in the Specification at page 1, line 25, and original claims 8 and 15. No new matter has been introduced.

Upon entry of the amendments, claims 1-24 will be pending and under examination. Applicant respectfully requests that the Examiner reconsider this application in view of the following remarks.

Specification Objections

The Examiner sets forth guidelines as to how to lay out a specification and suggests that Applicant follows them. See the Office Action, page 2, line 14 through page 3, line 17. Applicants have amended the Specification accordingly. In particular, section headings have been added.

The Examiner also points out that the four figures referred to in the Specification and a brief description of these figures are missing. See the Office Action, page 2, lines 2-13. Applicant has rectified these deficiencies.

Rejection under 35 U.S.C. § 101

The Examiner rejects claims 1-21 “because the claimed recitation of a use without setting forth any steps involved in the process, results in an improper definition of a process.” See the Office Action, page 4, lines 1-14. In other words, it is the Examiner’s position that, as the ‘use’ covered by claims 1-21 does not define a process, the claimed subject matter is not patentable.

Applicant has amended claims 1-21 so that they are now drawn to a product, which is statutory patentable subject matter.

Rejection under 35 U.S.C. § 112, 2nd paragraph

The Examiner rejects claims 1-21 as indefinite on the ground that the claimed use is unclear. See the Office Action, page 3, items 27-30. As stated above, claims 1-21 are now directed to a product, rather than a use.

The Examiner also rejects claims 8, 9, and 15 as indefinite on a second ground. According to the Examiner, the meaning of the phrase “in particular” is unclear. See the Office Action, page 4, lines 6-13. Applicant has removed the phrase and its related context from claims 8, 9, and 15.¹

The Examiner further rejects claims 12, 19, and 20 as indefinite on the ground that the meaning of the recited term “selected from the group of” is unclear. See the Office Action, page 5, lines 1-3. Applicants have replaced this term with “selected from the group consisting of” to obviate this rejection.

Rejection under 35 U.S.C. § 102

The Examiner rejects claims 1-7, 11-13, 15, and 21 as anticipated by Metplast Company INC, British Patent No. 656, 393 (“Metaplast”). See the Office Action, page 5, lines 11-12.

Independent claim 1 will be discussed first. This claim, as amended, covers a decorated product having a decorative structural part that contains a composite material including a non-metallic substrate **not chemically pretreated** before deposition of a metallic layer onto its surface.

According to the Examiner, Metaplast teaches a process for coating a surface of a polymer substrate with a metal. See the Office Action, page 5, lines 13-15. Metaplast also teaches that their method uses a solution of stannous chloride and hydrochloric acid to treat the surface of polymer substrate, an essential step in making it suitable for metalizing. See page 1, lines 70-75, and page 2, lines 15-24. In other words, Metaplast **requires chemically pretreating** a non-metallic substrate before deposition of a metallic layer on its surface. Clearly, a product produced by this method has a **chemically**

¹ The amendment to claims 8 and 15 has necessitated changing the dependency of claim 9 and adding of new claims 23 and 24.

pretreated non-metallic substrate, not a substrate that is **not chemically pretreated** as required by amended claim 1.

In short, Metaplast **teaches away** from the product of claim 1, as amended.

For the reasons set forth above, claim 1, as amended, is not anticipated by Metaplast. Nor are claims 2-7, 11-13, 15, and 21, which all depend, either directly or indirectly, from claim 1.

Rejection under 35 U.S.C. § 103

Claim 1-21 are rejected for obviousness on six grounds. Applicant addresses each ground separately below.

I

The Examiner rejects claims 1-7, 11-13, 15, 17, and 21 as obvious over Metaplast in view of Fadgen et al., U.S. Patent No. 3,607,352 ("Fadgen"). See the Office Action, page 10, lines 6-8. Among the rejected claims, only claim 1 is independent.

As discussed above, claim 1, as amended, covers a decorated product having a decorative structural part that contains a composite material including a non-metallic substrate **not chemically pretreated** before deposition of a metallic layer onto its surface.

As also discussed above, Metaplast **teaches away** from a product which includes a non-metallic substrate that is **not chemically pretreated** before deposition of a metallic layer onto its surface as required by amended claim 1.

Applicant now turns to Fadgen. According to the Examiner, Fadgen teaches electrolessly plating a non-metallic surface with a metal. See the Office Action, page 7, lines 4-6. Fadgen also teaches that a sensitizer solution is used to **pretreat** the non-metallic substrate prior to being contacted with the activator solution containing the deposition metal. See column 4, lines 35-45. In other words, the sensitizer solution taught in Fadgen is used to **chemically pretreat** a surface of a non-metallic substrate before deposition of a metallic layer. Indeed, Fadgen also teaches that it is only after multiple chemical pretreatment steps that the non-metallic substrate is electrolessly plated. See column 6, lines 25-37. Clearly, the product obtained by the Fadgen method

has a **chemically pretreated** non-metallic substrate, not a substrate that is **not chemically pretreated** as required by amended claim 1.

In short, Fadgen, like Metaplast, **teaches away** from the product of claim 1 as amended.

To conclude, claim 1 is not rendered obvious by both Metaplast and Fadgen, either alone or in combination. Nor are claims 2-7, 11-13, 15, 17, and 21.

II

The Examiner rejects claim 8 as obvious over Metaplast in view of Giltrow et al., U.S. Patent No. 3, 674, 689 ("Giltrow"). See the Office Action, page 7, lines 11-12. Applicant addresses this rejection as if it were directed at claim 1, from which claim 8 depends.

As discussed above, in the product of amended claim 1, a non-metallic substrate is **not chemically pretreated** before metal deposition onto its surface.

As also discussed above, Metaplast teaches away from a product including a non-metallic substrate **not chemically pretreated** before metal deposition as required by amended claim 1.

As correctly pointed out by the Examiner, Giltrow teaches a carbon fiber reinforced substrate with diameters between 5 and 15 mm. See the Office Action, page 7, lines 15-16. Hence, Giltrow does not make up for the deficiency of Metaplast.

In sum, Metaplast and Giltrow in combination do not render claim 1 obvious. Nor does their combination render obvious claim 8, which depends from claim 1.

III

The Examiner rejects claims 9 and 10 as obvious over Metaplast and Giltrow in view of Shaw et al., U.S. Patent No. 4, 643, 940 ("Shaw"). See the Office Action, page 8, lines 1-3. As claims 9 and 10 depend indirectly from claim 1, Applicant will address these rejections as if they were directed at claim 1.

Claim 1 has been discussed above.

As also discussed above, both Metaplast and Giltrow fail to suggest a feature of the product of claim 1, i.e., a non-metallic substrate **not chemically pretreated** before metal deposition onto its surface.

According to the Examiner states Shaw “teaches that a common fiber reinforcing materials are carbon and glass.” See the Office Action, page 8, lines 6-7. Thus, this reference does not make up for the deficiency of both Metaplast and Giltrow.

For the reasons set forth above, Applicants submit that Metaplast, Giltrow, and Shaw, in combination, do not render claim 1 obvious. They also do not render obvious claims 9 and 10 which depend from claim 1.

IV

The Examiner rejects claims 18 and 19 as obvious over Metaplast and Fadgen in view of Lemelson, U.S. Patent No. 4, 093, 693 (“Lemelson”). See the Office Action, page 8, lines 13-15. These two claims depend from claim 1.

As discussed above, both Metaplast and Fadagen **teach away** from a non-metallic substrate **not chemically pretreated** before metal deposition as required by amended claim 1.

According to the Examiner, Lemelson teaches that it is well known to use silicone carbide with metals to reinforce a polymeric matrix. See the Office Action, page 8, lines 18-20. Thus, this reference also does not make up for the deficiency of both Metaplast and Fadagen.

Applicants submit that Metaplast, Fadagen, and Lemelson, in combination, do not render claim 1 obvious. They also do not render obvious claims 18 and 19, both of which depend from claim 1.

V

The Examiner rejects claim 20 as obvious over Metaplast and Lemelson in view of Stenzel et al., U.S. Patent No. 5, 648, 620 (“Stenzel”). See the Office Action, page 9, lines 4-6. Claim 20 depends from claim 1.

As discussed above, neither Metaplast nor Lemelson suggests a feature of the product of claim 1, i.e., a non-metallic substrate is **not chemically pretreated** before metal deposition onto its surface.

According to the Examiner, Stenzel teaches that it is known to embed molybdenum sulphide in metal substances to increase friction reducing properties. Stenzel therefore does not cure Metaplast and Lemelson of their deficiency.

For the reasons set forth above, Applicant submits that these three references in combination do not render claim 1 obvious. Nor does their combination render obvious claim 20, which depends from claim 1.

VI

The Examiner rejects claims 14 and 16 as obvious over Metaplast in view of Kurfamn, U.S. Patent No. 4, 510, 208 ("Kurgman"). See the Office Action, page 9, lines 14-15. Both of the rejected claims depend from claim 1.

Applicant reiterates that Metaplast does not suggest (actually, teaches away from) a product including a non-metallic substrate **not chemically pretreated** before metal deposition onto its surface, as required by claim 1.

As correctly pointed out by the Examiner, Kurgman teaches that "polypropylene and PTFE are useful substrated for coating with a metal layer of layers." See the Office Action, page 9, lines 18-19. Thus, Kurgman also does not suggest a non-metallic substrate **not chemically pretreated** before metal deposition onto its surface as required by claim 1. Applicant therefore submits that Metaplast in combination with Kurgman do not render claim 1 obvious. Nor does their combination render obvious claims 14 and 16, which depend from claim 1.

New claims

Three new dependent claims, i.e., claims 22-24, have been added to cover particular embodiments of this invention.

These new claims depend, either directly or indirectly, from claim 1. For the same reasons set forth above, these new claims are patentable over Metaplast and Fadagen, either alone or in combination.

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Applicants respectfully request that upon allowance of claim 1, these new claims also be allowed.

New abstract

A sheet containing a new abstract is co-filed herewith.

CONCLUSION

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment. The excess claims fee in the amount of \$156 and the Petition for Extension of Time fee in the amount of \$130 is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization.

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Respectfully submitted,

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